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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,380	11/24/2000	Krister Hansson	TTP 31349	3719

7590 09/01/2004

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Washington, DC 20036

EXAMINER

GARLAND, STEVEN R

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/718,380	Applicant(s) HANSSON ET AL.	
	Examiner Steven R Garland	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 27-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 27-29, 31 is/are rejected.
- 7) ☒ Claim(s) 30 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The declaration filed on 5/28/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Chen 6,617,009 reference.

Ingvar Sylegard is not the inventor of the claimed subject matter or a party qualified under 37 CFR 1.42, 1.43, or 1.47 to make a declaration under 37 CFR 1.131.

The declaration is therefore defective, since it is not made by a qualified party.

Also note MPEP 715.07 which states the following:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

Applicant has also has not explained what the declaration is being relied to show. Any declaration being filled under 37 CFR 1.131 must comply with the requirements of 37 CFR 1.131. Also see MPEP sections 715.04, 715.07-715.07(c).

2. The declaration by Ingvar Sylegard, also refers to a verified translation of the Swedish priority document which is an attachment to the declaration. The Swedish priority document however has a later date than the effective filing date of the Chen reference and is ineffective to overcome the Chen reference.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-21, 27- 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Chen et al. 6,617,009.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc.

See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

In regards to the printing, Mckee in col. 3, lines 59-60 does teach cutting tiles with a device similar to an ink jet printer, but in lines 60-63, Mckee teaches dye or glaze using such as a system and provides other details in col. 15, lines 21-47, but simply fails to use the term printing. Also Mckee teaches printing patterns on tiles in col. 1, lines 41-63.

Mckee while teaching the use of printed tiles does not specifically use them or go into details about segmentation of the border region since this is a function of the decor being implemented.

It would have been obvious to one of ordinary skill in the art to modify Mckee to allow the use of printed tiles for ease in manufacture.

Further it would have been obvious to one of ordinary skill in the art to modify Mckee to allow segmentation of the border region and choice in decor being applied to the border region so that the selected artistic rendering could be accomplished.

Mckee however does not teach the use of tongue and grooved elements or providing a protective layer by spray coating, curtain coating etc. Mckee does teach the use of a protective coating but requires that coating element be required to withstand high temperatures.

Chen et al. teaches the use of tongue and grooved elements which inherently require the use of a "intermediate distance " to form a tongue or groove and applying a

protective coating without the use of high temperatures. See col. 3, lines 1-8; col. 6, lines 7-22; and col. 11, lines 41-67.

It would have been obvious to one of ordinary skill in the art to modify Mckee in view of Chen and use tongue and grooved elements for ease in keeping the surface flat and also to provide a protective coating by coating a plastic tile if the tile can not stand high temperatures to prevent damage to the surface.

In response to applicant's arguments, as noted above the declaration under 37 CFR 1.131 is ineffective to overcome the Chen reference. Further Mckee teaches that the overall design can be pictorial, abstract, derived from a photos, etc. See col. 2, line 65 to col. 3, line 4; col. 5, lines 10-46; col. 8, lines 1-45.\

6. Claims 1,2,6,14-16,19,20, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mckee 5,568,391 in view of Newton et al. 6,504,559 and Chen et al. 6,617,009.

Mckee teaches use of a computer implemented system for decorating a surface such as flooring. Mckee further teaches dividing the surface into surface elements, decorating the surface elements so that when elements are arranged in the correct layout using a diagram and instructions that the desired artistic rendering is achieved. Mckee teaches the use of printed tiles; use of various sizes and shapes of tiles and matted tiles to fit a customers design requirements; labeling and packaging tiles; use of various types of materials for the tiles; printing installation instructions; output of the desired pattern to a screen or other device; use of scanned images; various visual effects including blending or sharp lines between elements; use of borders; operator

selection of visual effects and patterns; protective wear layer, plastic tiles (polymer),etc.

See the abstract; figures; col. 1, lines 10-17 and 41-63; col. 2, lines 33-55; col. 3, line 1 to col. 4, line 61; and col. 5, lines 10-67; and col. 6, line 48 on.

Mckee while teaching the use of printed tiles does not specifically use them. Even assuming that the process taught by Mckee in.col. 15, lines 21-47, is not "printing" on tiles.

Newton et al. teaches printing a pattern on a tile. See col. 2, lines 44-52; col. 3, lines 7-20; col. 4, lines 19-27; and col. 7, lines 55-62.

It would have been obvious to one of ordinary skill in the art to modify Mckee in view of Newton to allow the use of printed tiles for ease in manufacture and the production of small production runs.

Mckee and Newton however do not teach the use of tongue and grooved elements or providing a protective layer by spray coating, curtain coating etc. Mckee does teach the use of a protective coating but requires that coating element be required to withstand high temperatures.

Chen et al. teaches the use of tongue and grooved elements which inherently require the use of a "intermediate distance " to form a tongue or groove and applying a protective coating without the use of high temperatures. See col. 3, lines 1-8; col. 6, lines 7-22; and col. 11, lines 41-67.

It would have been obvious to one of ordinary skill in the art to modify Mckee and Newton in view of Chen and use tongue and grooved elements for ease in keeping the

surface flat and also to provide a protective coating by coating a plastic tile if the tile can not stand high temperatures to prevent damage to the surface.

In response to applicant's arguments, as noted above the declaration under 37 CFR 1.131 is ineffective to overcome the Chen reference.

7. Claims 30 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

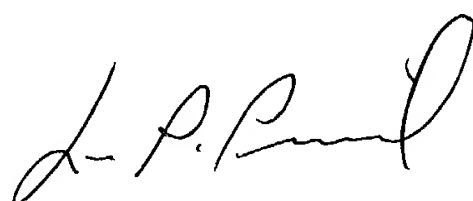
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-

9759, after 10/13/04 at 571-272-3741. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on 703-308-0538 after 10/12/04 at (571)272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sno

Steven R Garland
Examiner
Art Unit 2125

LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100